

REMARKS

Reconsideration and allowance of all the claims of record are respectfully requested.

Claims 1, 3, 11, 14, 16, 19, 22 and 23 have been amended to more clearly define the applicants' invention and, in so doing, to even more clearly distinguish over the prior art applied by the Examiner. Claim 16 has been amended to cure the lack of antecedent basis issue identified by the Examiner in the first official action. New claims 25-31 have been added to ensure that the applicants' invention is appropriately protected.

With respect to prior art rejections, claims 1, 3-5 and 7 stand rejected under 35 U.S.C. §102 as being anticipated by Saito et al.; claims 9 and 10 stand rejected under 35 U.S.C. §103 as being unpatentable over Saito; and claims 2, 6, 8, and 11-24 stand rejected under 35 U.S.C. §103 as being unpatentable over Saito et al. in view of Yamauchi.

For the reasons set forth below, the applicants submit that the Saito patent, either when considered alone or collectively with Yamauchi, fails to disclose or even remotely suggest the claimed invention as defined in each of the applicants independent claims 1, 11, 16, 22 and 25. The claims of record, particularly as presently amended, define a unique portable, palm-sized digital data transfer and repository apparatus and methodology which is not disclosed or suggested by Saito (and/or Yamauchi).

Turning first to the Examiner's "anticipation" rejection based upon Saito, in order for the Examiner to make a proper case of anticipation, it is necessary that each and every claim limitation be disclosed in Saito, either expressly or under principles of inherency.

See, for example, Kalman v. Kimberly-Clark Corp., 218 USPQ 701, 709 (Fed. Cir. 1983). Under the doctrine of inherency, if an element is not expressly disclosed in a prior art reference, the reference may only be deemed to anticipate a claim if the missing element “is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Cont’l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). “Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)).

Independent claims 1, 11, 16, 22 and 25, in various ways, each define, *inter alia*, 1) a palm-sized device, 2) a portable digital data transfer and repository device for use for transferring data between a removable memory module and a user's computer, 3) a mass storage device which is accessible for data transfer with a user's computer; and 4) an output interface, coupled to said mass storage device, for use in transferring data between said mass storage device and said user's computer, said output interface being compatible with an interface of said user's computer.

The applicants submit that Saito lacks such features required by each of the claims of record (in one form or another). Saito does not disclose or suggest a palm-sized, portable digital data transfer and repository device for use for transferring data between a removable memory module and a user's computer. Likewise, Saito does not disclose or suggest a mass storage device which is accessible for data transfer with a user's computer.

Neither, does Saito disclose or suggest an "output interface, coupled to said mass storage device, for use in transferring data between said mass storage device and said user's computer, said output interface being compatible with an interface of said user's computer."

Thus, the claims expressly define a device which is not disclosed by Saito and exists independently from a user's computer such as the laptop computer which the Examiner relies on for providing various claimed features such as the claimed insertion port, the mass storage device, etc. The claim requirement of an "output interface" which is coupled to said mass storage device, for use in transferring data between said mass storage device and said user's computer, where the output interface is required to be "compatible with an interface of said user's computer" is likewise not disclosed or suggested by Saito.

Focussing, for example, on Figures 1 and 2 of Saito, the memory card 20 is inserted directly into the user's laptop computer 30. The claims of record require, *inter alia*, the particular structural elements which must be embodied in a device which exists independently of, and yet is designed to interface with, a user's computer. For these reasons alone, there can be no anticipation by Saito.

Turning next to the Examiner's rejections based upon obviousness, the applicants submit that Saito, whether considered alone or in combination with Yamauchi, fails to suggest the claimed combination.

A significant objective of Saito is to provide a new camera design whose memory module may be more conveniently connected to a host computer than is accommodated

by typical camera designs. The configuration of the camera is designed to match the form of a PC card (physically and electrically) to make plugging-into the host computer more convenient, and to allow remote operation of the camera from the host when it is plugged into the computer. Such a design suggests directly connecting the host computer compatible memory card - without the use of an intermediary data repository.

The claimed invention defines a combination of apparatus elements and method steps which are not suggested by the Saito disclosure. The claimed invention provides a portable repository and transfer device for storing and transferring images or other digital data produced by existing and future digital cameras (or other devices), without requiring modification to those cameras (or other devices).

The "palm-sized", hand-held device defined in the subject application can, for example, accept standard camera memory modules (SmartMedia, Compact Flash, Memory Stick, etc.) and copy the contents of these memory modules to a mass storage embedded in the device. If the images collected in the device are later transferred to a host computer (laptop or desktop PC), no part of the original camera(s) or memory module(s) used to collect the images are involved.

In contrast with the claimed invention, Saito does not describe an independent accessory, which can be used with any camera or any other device which stores data from standard memory modules. Rather, Saito defines a new form of a camera interaction with a PC, such as a laptop, through the laptop's PC card interface and, thus, describes an improved method for connecting the electronic still camera to the laptop.

The claim limitations which clarify that the data repository device can not be a laptop computer such as disclosed in Saito are significant. A laptop computer is too large, power-hungry and heavy for a photographer to easily carry anywhere while taking photographs.

In contrast, the claimed invention is palm-sized and can be easily carried and used in situations where the contents of the camera's memory module needs to be transferred to a mass storage so the module can be reused, particularly when filled unexpectedly. This device allows, for example, a photographer to recover from unexpectedly filling up a camera memory module while hiking around the Grand Canyon and to conveniently reuse the memory module. Such a photographer will not likely be carrying a laptop under such circumstances, but may easily carry the device claimed herein.

Subsequently, after a series of photography excursions, the claimed invention can be used to transfer the captured images via the claimed "output interface (e.g., a USB interface as shown in applicants' Figure 2)" to the user's laptop or desktop computer, in an environment where the bulkiness of the computer is no longer an issue. The claimed invention advantageously provides a convenient device for the conveyance of numerous images (perhaps many multiples of the number of images that will fit on one or more camera memory modules) between camera and computer.

The Yamauchi reference relied on by the Examiner fails to cure the above-identified deficiencies of the Saito reference. The relevant portions of the Yamauchi patent referenced in the Office Action describe an image data editing machine such as shown in Figure 62 that includes (among other features) slots for memory modules.

However, such an editing machine is intended for interactive use in viewing and managing image data, much in the manner a laptop can be used to perform the same functions. As such, it is not suitable in size, power requirements, and convenience to be used as a palm-sized, portable image capture and transfer device having the features claimed and would not have suggested such features. Moreover, even if Saito's laptop device were to be modified in the manner urged by the Examiner such a modification would not have resulted in the claimed features which are identified above that are independent from the user's host computer.

Even if the Examiner were of the view that it is conceivable that the applied references could be modified so as to result in the claimed invention, such a modification would not have been obvious within the meaning of 35 U.S.C. §103, unless the prior art suggests the desirability of such a modification. See In re Gordon, 773 F.2d 900 (Fed. Cir. 1984), and In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1 (Fed. Cir. 1983). Absent any such suggestion, the applicants can only conclude that any continued rejection based upon the applied references must necessarily be grounded upon an improper hindsight reconstruction.


In light of the lack of the above-identified specific teachings in the applied references, the Examiner has failed to present a *prima facie* case of unpatentability of the claimed invention. Unless such a case is presented, the applicants are entitled to the grant of a patent based upon the present application. See In re Oetiker, 24 U.S.P.Q. 2nd 1443 at 1444 (Fed. Cir. 1992).

In view of the foregoing, the applicants believe that all of the claims are in condition for allowance and action to that end is earnestly solicited. If any issues remain to be resolved, the Examiner is urged to contact applicants' attorney at the telephone number listed below.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached pages are captioned "**Version With Markings To Show Changes Made.**"

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

1. (Amended) A portable, palm sized, hand-held, digital camera picture image data transfer and repository device for use for transferring said image data between [with] a removable memory module of a digital camera and a user's computer comprising:

a housing of a size to be held in the palm of a user's hand and including a memory input port sized to receive a digital camera memory module;

a mass storage device operatively coupled to receive and store picture image data from a digital camera memory module inserted into said memory input port and for storing said image data, said mass storage device being accessible for downloading said image data to a user's computer; [and]

data transfer circuitry for controlling the transfer of data stored in said digital camera module inserted into said memory input port to said mass storage device, and

an output interface, coupled to said mass storage device, for use in transferring image data stored in said mass storage device to said user's computer, said output interface being compatible with an interface of said user's computer.

3. (Amended) A portable, hand-held, digital camera picture image data transfer and repository device in accordance with claim 1, [further including:] wherein said output

interface includes a USB interface [an output port] operatively coupled to said mass storage device for transferring picture image data to a user's computer.

11. (Amended) A portable, palm sized, hand-held, general purpose, digital data transfer and repository device for use for transferring said data between [with] a removable memory module and a user's computer comprising:

a housing of a size to be held in the palm of a user's hand and including

a [first] memory insertion section [input port] for receiving a first digital memory module, and [a second memory input port] for receiving a second digital memory module,

a mass storage device contained within said hand-held housing and operatively coupled to receive and store digital data from [both] said first digital memory module and said second digital memory module, [inserted into said first and second memory input ports] said mass storage device being accessible for data transfer with a user's computer;

processing circuitry contained within said hand-held housing for controlling the transfer of data stored in said first digital memory module and second digital memory module to said mass storage device, and

an output interface, coupled to said mass storage device, for use in transferring data between said mass storage device and said user's computer, said output interface being compatible with an interface of said user's computer.

14. (Amended) A portable, hand-held, digital data transfer and repository device in accordance with claim 11, [further including:] wherein said output interface includes a USB interface [an output port] operatively coupled to said mass storage device for transferring data to a user's computer.

16. (Amended) A portable, palm sized, hand-held, digital data transfer and repository device for use for transferring data between [with] a removable memory module and a user's computer comprising:

a housing of a size to be held in the palm of a user's hand and including

a memory input port for receiving a digital memory module,

a mass storage device contained within said hand-held housing and operatively coupled to receive and store digital data from [both] said [first] digital memory module and said second digital memory module] inserted into said [first and second] memory input [ports] port, said mass storage device being accessible for data transfer with a user's computer;

at least one control key for initiating [a] an operation relating to the [transfer of] data stored in said [from a] digital memory module; [resident in said input port to said mass storage device; and]

processing circuitry contained within said hand-held housing [and responsive to the actuation of at least one control key] for controlling the transfer of data stored in said digital memory module to said mass storage device, and

an output interface, coupled to said mass storage device, for use in transferring data between said mass storage device and said user's computer, said output interface being compatible with an interface of said user's computer.

19 (Amended) A portable, hand-held, digital data transfer and repository device in accordance with claim 16, [further including:] wherein said output interface includes a USB interface [an output port] operatively coupled to said mass storage device for transferring data to a user's computer.

22 (Amended) A method of operating a portable, palm-sized, hand-held digital camera picture image data transfer and repository device to permit the digital camera memory module to be reused, said data transfer and repository device including a mass storage device and being operable to transfer said image data between a removable memory module of a digital camera and a user's computer and further including an output interface, coupled to said mass storage device, for use in transferring image data stored in

said mass storage device to said user's computer, said output interface being compatible with an interface of said user's computer, said method comprising the steps of:

inserting into a memory [inport] input port of said repository device a digital camera memory module having picture image data stored therein;

[initiating under user control a data] transferring [of] picture image data from the digital memory module to [a] said mass storage device within said repository device; and

reformatting said digital camera memory module so that it may be reinserted into a digital camera for picture taking.

23 (Amended) A method according to claim 22, further including the step of:

transferring picture image data to a user's computer via [an] said output [port] interface in said portable repository device.